

Application Serial No.: 09/672,987
Attorney Docket No.: 0190227

REMARKS

This Amendment and Response is in response to the *Final Office Action* of May 18, 2005, where the Examiner has rejected claims 5, 6, 9, 10, 14, 17, 19-21 and 24. By the present amendment, claims 9, 10, 14, 17, 19, 20 and 21 have been cancelled. After the present amendment, claims 5, 6 and 24 are pending in the present application. Allowance of outstanding claims 5, 6 and 24 in view of the following remarks is respectfully requested.

A. Rejection of Claims 5, 14 and 24 under 35 USC §103(a)

The Examiner has rejected claims 5, 14 and 24, under 35 USC §103(a), as being unpatentable over Wilder, et al. (USPN 5,262,871) ("Wilder") in view of Palcic, et al. (USPN 5,827,190) ("Palcic").

The Examiner has acknowledged that Wilder fails to disclose or teach that "the image processor detects whether there is a low incident light condition, and if so, captures the image using the low-resolution mode of the circuit." However, the Examiner asserts that Palcic discloses this limitation, at col. 4, lines 6-11, which reads:

image sensing means at the inner end of the probe to detect tissue fluorescence, the image sensing means having a light sensitivity that can be increased to acquire low resolution images at low fluorescent light intensities and decreased to acquire high resolution images at other light intensities.

Applicant respectfully but strongly disagrees with the Examiner's characterization of the aforementioned excerpt of Palcic for the reasons stated below.

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Palcic clarifies the aforementioned excerpt (which is part of the claim language) in the detailed description of Palcic, at col. 9, lines 8-14, which reads:

The endoscope apparatus of the fourth embodiment is able to collect the faint fluorescence images that provide information necessary for delineating diseased and normal tissue by virtue of the fact that CCD sensor 12 is provided with a light sensitivity that can be increased to acquire low resolution images at low fluorescent light intensities and decreased to acquire high resolution images at other light intensities.

In other words, Palcic discloses that if CCD sensor 12 is in low resolution mode, the light sensitivity of CCD sensor 12 can be increased to acquire the image, and if CCD sensor 12 is in high resolution mode, the light sensitivity of CCD sensor 12 can be decreased to acquire the image. However, Palcic does not come close to disclosing, teaching or suggesting that "the image processor detects whether there is a low incident light condition, and if so, captures the image using the low-resolution mode of the circuit." In contrast, Palcic simply discloses that the lighting condition is adjusted in each mode, but falls completely short of teaching or suggesting that the lighting condition is used to select between the low resolution and high resolution modes.

The Examiner relies upon Wilder for disclosing "selection between a low resolution mode and a high resolution mode," however, indeed, such disclosure does not teach or suggest a desirability of using the lighting conditions for selecting between modes. Further, as discussed above, Palcic also fails to teach or suggest a desirability of using the lighting conditions for such selection. Even more, the Examiner's approach is to modify the disclosure or teaching of Palcic, which is "adjusting the lighting condition

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while in a particular mode," to stand for "using the lighting condition to select between modes."

Therefore, the Examiner's approach not only combines two references without any suggestion of a desirability by either reference to use the lighting condition to select between modes, but also the Examiner modifies the teaching of Palcic from "adjusting the lighting condition while in a particular mode" to "using the lighting condition to select between modes," without any suggestion of a desirability by the references to make such modification to Palcic.

To this end, applicant would like to direct the Examiner's attention to the guidance from the Federal Circuit:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification" (emphasis added) (In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984) (see also In re Fitch, 972 F.2d 1260 (Fed. Cir. 1992)).

In a proper obviousness determination, "whether the changes from the prior art are 'minor', ... the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's ... device." (citations omitted.) This includes what could be characterized as simple changes, as in *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down). (emphasis added) (In re Chu, 66 F.3d 292, 298 (Fed. Cir. 1995)).

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Accordingly, applicant respectfully requests the that Examiner reconsiders the rejection of claim 5 based on Wilder and Palcic, for the reasons stated above, and allow claim 5 of the present application.

Further, at least for the reasons stated above, claim 24 should also be allowed, because claim 24 recites "means for detecting incident lighting conditions and selecting the low-resolution mode if the incident lighting conditions disfavor the high-resolution mode."

By the present amendment, claim 14 has been cancelled. Therefore, applicant respectfully submits that the Examiner's rejection of claim 14 has been rendered moot.

B. Rejection of Claims 6 and 17 under 35 USC §103(a)

The Examiner has rejected claims 6 and 17, under 35 USC §103(a), as being unpatentable over Wilder in view of Anderson, et al. (USPN 6,233,016) ("Anderson"), and further in view of Kuroiwa (US Pub. 2001/0017658) ("Kuroiwa").

The Examiner has acknowledged that Wilder fails to disclose or teach that "the image processor detects whether there is a low power condition, and if so, captures the image using the low-resolution mode of the circuit." However, the Examiner asserts that Anderson discloses detection of a low power condition and issues a signal to turn off the flash unit. The Examiner goes on to further acknowledge that Anderson teaches that the entire unit is turned off and fails to disclose or teach that a low resolution mode is

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selected. However, the Examiner also attempts to fill this gap using Kuroiwa for a teaching that sub-sampling reduces resolution and power consumption.

Applicant respectfully disagrees. First, it is respectfully submitted that Kuroiwa relates to displaying images and not capturing images. In other words, Kuroiwa describes sub-sampling the image after the image has been captured to generate a low resolution image. Kuroiwa does not relate to capturing an image in a low resolution mode for lowering the power consumption.

Furthermore, applicant respectfully submits that assuming, arguendo, that the Examiner's characterization of Anderson and Kuroiwa is correct (although applicant maintains an opposing view), contrary to the Examiner's statements, for the reasons stated below, there is no teaching or suggestion by either reference, whatsoever, to combine Anderson and Kuroiwa with Wilder, as described by the Examiner. Applicant respectfully submits that there is no disclosure in Anderson that remotely suggests a desirability of detecting low power for signaling a selection of a low resolution mode as opposed to a high resolution mode. In fact, not only Anderson does not suggest a desirability of such selection in response to a low power detection, but Anderson also teaches away by disclosing that a signal is sent to turn off an entire unit, i.e. the flash unit. Furthermore, Kuroiwa relates to processing a captured image to obtain a low resolution image by subsampling. Kuroiwa does not suggest a desirability of using a low resolution mode for capturing an image to reduce power consumption in response to a low power detection.

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As stated above, the Federal Circuit has explicitly stated that a prior art cannot be modified to render an invention obvious "unless the prior art suggested the desirability of the modification." (emphasis added.) (In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984) (see also In re Fitch, 972 F.2d 1260 (Fed. Cir. 1992)). Therefore, applicant respectfully submits that there is no suggestion of a desirability to modify Kuroiwa to capture an image in a low resolution mode to reduce power consumption, since Kuroiwa merely suggests the subsampling of an already captured image to generate a low resolution image. Accordingly, applicant respectfully submits that claim 6 should be allowed.

Also, by the present amendment, claim 17 has been cancelled. Therefore, applicant respectfully submits that the Examiner's rejection of claim 17 has been rendered moot.

C. Rejection of Claims 9, 10 and 19-21 under 35 USC §103(a)

The Examiner has rejected claims 9, 10 and 19-21, under 35 USC §103(a), as being unpatentable over Wilder in view of Smith (USPN 5,418,565) ("Smith").

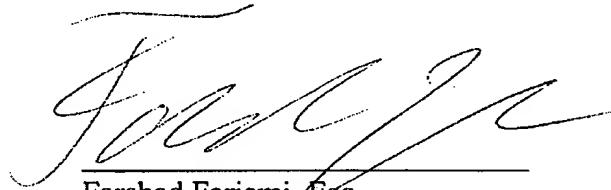
By the present amendment, claims 9, 10 and 19-21 have been cancelled. Therefore, applicant respectfully submits that the Examiner's rejection of claims 9, 10 and 19-21 have been rendered moot.

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D. Conclusion

Based on the foregoing reasons, an early Notice of Allowance directed to all claims 5, 6 and 24 pending in the present application is respectfully requested.

Respectfully Submitted,
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7/20/2005
Date

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